

REMARKS

The Amendment presented above repeats the non-entered amendment of May 4, 2004, which applicants understand is to be entirely disregarded, and the above Amendment further takes into account and addresses the points raised by the examiner in the Advisory Action mailed May 25, 2004.

The final Action mailed January 21, 2004, has been carefully reviewed. Upon entry of the amendments presented above, the claims in the application would be claims 1, 2, 4, 6, 8, 9, 11-16 and 31-44. These claims are believed to be patentable consistent with what is stated in the final Office Action. Accordingly, applicants respectfully request favorable consideration, entry of the amendments presented above, and early formal allowance.

The typographical error objected to in claim 9 is proposed to be corrected above, and will be corrected upon entry of the amendments presented above.

Claim 12 has been objected to as being improperly dependent on claim 11. Claim 11 is proposed to be amended above in such a way as to provide proper antecedent basis for claim 12, whereby this claim objection should be overcome upon entry of the amendments submitted above.

No rejections have been imposed under Sections 102 or 103, and paragraph 8 of the final Action indicates that the claims are free of prior art. Accordingly, applicants understand that their claims are deemed by the PTO to define novel and unobvious subject matter under Sections 102 and 103. Also, paragraphs 9 and 10 of the Official Action indicate specifically that certain claims would be allowable if amended to overcome specified informalities, these informalities being discussed below.

Claims 1, 2, 4, 6, 8, 9, 11-16, 41 and 43 have been rejected under the first paragraph of Section 112. This rejection is respectfully traversed.

Applicants do agree that the presence of claim 17 dependent on claim 1 was improper, and therefore claim 17 is proposed above to be deleted.¹ Applicants do not agree that reference in the preamble to the transformation of tomato or melon means that claim 1 could properly be interpreted as being directed to the genetic transformation of other plants. Nevertheless, as the examiner's helpful suggestion is not unreasonable, it has been adopted in the amendment proposed above, i.e. what appears in the preamble of claim 1 is proposed to be carried over to part (g) of claim 1. Upon

¹ Claims 45 and 46 are similarly proposed to be deleted.

entry of the amendments presented above, such amendment should obviate this rejection.

However, for the record, applicants submit that such an amendment is entirely cosmetic and is not required for any purpose relating to patentability because the scope of the claims not reduced by such amendment. No limitations are proposed to be added and none are intended; the meaning of the claims remains the same.

Applicants respectfully request entry of the amendments to claim 1 and withdrawal of the rejection.

Claims 1, 2, 4, 6, 8, 9, 11-17 and 31-46 have been rejected under the second paragraph of Section 112. This rejection is respectfully traversed.

The amendments proposed above fall into two categories, namely those made in deference to the examiner's views even though unnecessary, and those made to improve the form of the claims. In this latter group are the amendments to claims 11 and 37, which are proposed to be amended substantially in order to better conform with U.S. practice. Applicants believe and respectfully submit that the claims as previously drafted, especially when considered in light of applicants' specification (fully consistent with the law), would not have been confusing to those skilled in the art, and therefore the claims (with the possible exceptions of claims

11 and 37) in their previous form are fully in accordance with Section 112. At worst, the claims in their previous form might be considered objectionable, but only as to form, requiring no substantial amendments relating to patentability.

As regards the criticism of the terminology "selection of" appearing in claims 1 and 31, part (h), certainly such language would not be confusing to those skilled in the art. Thus, the examiner's suggested amendment, adopted in the proposed amendments submitted above, is entirely cosmetic constituting no change in scope or meaning whatsoever.

As regards claim 36, allegedly lacking antecedent basis in the terminology "said solution of plasmid DNA", it is respectfully noted that claim 36 depends from claim 35 which explicitly states that "said DNA solution is a **solution of plasmid DNA.**" Thus, the antecedent basis for "said solution of plasmid DNA" appearing in claim 36 finds direct and precise antecedent basis in claim 35.

As regards claim 38, the clerical error in omitting the word "gene" is proposed to be corrected by amendment submitted above. For the record, however, claim 38 is not indefinite in its previous form (before entry of the amendment presented above), because antecedent basis need not be precise, but only understandable, noting MPEP 2173.05(e), and

especially its reference to *Ex parte Porter*, 25 USPQ2d 1144, 1145 (BPAI 1992).

In claims 11 and 37 as presented above, the expression "a phenotypic expression of another cloned selectable marker gene" no longer appears. The objected to articles "the", "an" and "a" previously appearing in claim 11 and 37 no longer appear in these claims as proposed above. The objected to expression in claim 12 is proposed to be deleted in the amendment submitted above, even though the antecedent basis is very clear. Antecedent basis in claim 32 for "said silicon carbide fibers" has now been inserted into claim 31 in the amendment proposed above.

Accordingly, at least with respect to the claims discussed above, the amendments are of a formal nature only, i.e. made to place the claims in improved form for U.S. practice or the examiner's understanding thereof. Such amendments are clearly not "narrowing" amendments because the scope of the claims is not proposed to be reduced at all as a result of such amendments. No limitations are proposed to be added in these regards and none are intended; the meaning of the claims remains the same.

Applicants respectfully request withdrawal of the rejection based on the second paragraph of Section 112.

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Reply to Office Action of 1/21/04 and 5/25/04

Applicants believe that all issues have been addressed above and resolved by entry of the amendments presented above and applicants' remarks. Applicants' claims being free of the prior art, applicants respectfully request favorable consideration, entry of the amendments presented above and early formal allowance.

Nevertheless, if any problems remain, applicants again request the favor of a telephone call from the examiner to undersigned to orally resolve any remaining outstanding issues.

Respectfully submitted,

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